

Remarks

Claims 1-9, 12-18, 21-25, 28-30 and 33-37 are pending in the current application. Claims 1, 2, 13, 14, 21, 23, 30, 33, 34 and 36 are amended to recite the dosage forms of optically pure (S) fluoxetine. Claims 10-11, 19-20, 26-27 and 31-32 are accordingly canceled for formal reasons, and without prejudice to Applicants' right to pursue them in one or more divisional, continuation and continuation-in-part applications. No new matter has been introduced.

The claims now pending in this application are directed to dosage forms of optically pure (S) fluoxetine, including lactose-free, stable, and disintegrating tablet dosage forms.

A. The Rejection Under 35 U.S.C. § 102(e) Should Be Withdrawn

Claims 21 and 29 are rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 5,830,500 to El-Rashidy et al. ("the '500 patent"). Although Applicants respectfully disagree with the substance of the rejection, claim 21 has been amended in such a way that obviates the rejection. In particular, amended claim 21 recites (S) fluoxetine, which is not disclosed by the '500 patent. In light of this amendment, Applicants respectfully request that the rejection under 35 U.S.C. § 102(e) be withdrawn.

B. The Rejection Under 35 U.S.C. § 103(a) Should Be Withdrawn

Claims 1-37 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over the '500 patent in view of U.S. Patent Nos. 5,104,899 ("the 899 patent") and 5,648,396 ("the '396 patent") both to Young et al., and WO 97/28788 to Camilo et al. ("the '788 application"). Applicants respectfully traverse this rejection for the reasons set forth below.

In particular, it is alleged that the pending claims would have been obvious to the person of ordinary skill in the art because the '500 patent disclosed fluoxetine compositions made from dry ingredients and do not contain lactose, and the '899 patent and the '396 patent respectively disclosed the use of (S) and (R) fluoxetine for treating depression. Moreover, it is alleged that the composition of this invention, which does not dissolve in less than three minutes is also obvious in light of the '500 patent because the '500 patent disclosed that the then-commercially

available fluoxetine compositions dissolve in 4 minutes and 36 seconds. Applicants respectfully disagree.

As the Examiner is well aware, a *prima facie* case of obviousness over a combination of references can only be made if, at the time of the invention, a motivation to combine the references existed. In re Jones, 958 F.2d 347 (Fed. Cir. 1992). Applicants respectfully submit that such a motivation to combine the '500 patent and the '899 patent did not exist at the time of this invention¹.

As was pointed out on page 4 of the Office action, the '500 patent did not disclose compositions that contain optically pure fluoxetine. On the other hand, the '899 patent did not disclose compositions containing (S) fluoxetine that are lactose-free or anhydrous. Applicants respectfully submit that the '500 patent would not motivate the person of ordinary skill in the art to alter a composition disclosed in the '899 patent such that it contains no lactose or water because the '500 patent is completely silent as to the advantages associated with fluoxetine compositions that are lactose or water free.

As evidenced by this lack of disclosure regarding the advantages of lactose-free fluoxetine compositions, the composition disclosed in the '500 patent merely happened to contain no lactose. The '500 patent does not suggest that lactose should be avoided in its compositions, much less in compositions containing (S) fluoxetine. Such a disclosure is simply not sufficient for the person of ordinary skill in the art to recognize the importance of the absence of lactose, let alone to be motivated to modify the compositions disclosed in the '899 patent.

Moreover, even assuming, for the sake of argument, that the '500 patent did suggest that lactose should be avoided in (S) fluoxetine compositions, it would not have suggested to one of ordinary skill in the art slowly dissolving dosage form, such as those recited by claims 13, 14, 16, 30 and 37. This is because the '500 patent is directed to the prevention of premature ejaculation, and thus teaches away from dosage forms that do not "provide[s] a relatively rapid release of a drug such as fluoxetine." The '500 patent, col. 1, lines 6-7.

Furthermore, contrary to what is alleged in the Office Action, the '500 patent does not disclose an anhydrous fluoxetine composition. It is respectfully

¹ Applicants respectfully point out that as the '396 patent merely discloses the use of (R) fluoxetine, it teaches away from the presently claimed invention.

submitted that the '500 patent's disclosure is directed to a mere "dry process" of making such a composition. As recognized by the Examiner, the term "anhydrous" is defined as substantially free of unbound water or the amount of unbound water is insufficient to accelerate incompatibility between fluoxetine and lactose in this application. Such a definition is simply not the same as mere mixing of dry ingredients.

For example, the procedure disclosed in the '500 patent ignores atmospheric water. Depending on the humidity of the environment in which the dosage form is manufactured, different dosage forms may contain different amount of water. Mere mixing of dry ingredients, without precautions such as preventing the atmospheric water from being incorporated into the final compositions, can very well lead to a "hydrous" composition. Therefore, the '500 patent does not teach or suggest that its compositions must be anhydrous by directing the persons of ordinary skill in the art to a mere mixing of dry ingredients.

On page 5 of the Office Action, it is alleged that because the dissolution time is an "art-recognized result-effective variable", it would have been obvious to the skilled artisan to optimize the dissolution time in light of the '500 patent's disclosure. Whether or not this may be the case, Applicants respectfully submit that, absent disclosure directed to the advantages of the dissolution time recited by the pending claims 13, 14, 16, 30 and 37, the skilled artisan would not have had a motivation to try to obtain the invention they recite.

The disclosure in '500 patent does not cure this deficiency. The dissolution time of 4 minutes and 36 seconds of a then-commercially available fluoxetine composition was disclosed to illustrate the rapid dissolution of the '500 patent's composition. It is evident that one of ordinary skill in the art would not have been motivated to achieve the disclosed dissolution time of 4 minutes and 36 seconds when such a dissolution time was disclosed as being a disadvantage. In other words, the '500 patent taught away from a fluoxetine composition having a dissolution time of longer than 5 minutes.

For this and the foregoing reasons Applicants respectfully submit that the rejection based on 35 U.S.C. § 103(a) should be withdrawn.

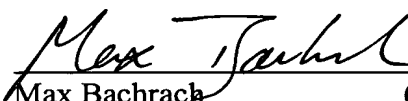
Conclusion

For the foregoing reasons, Applicants respectfully submit that claims 1-9, 12-18, 21-25, 28-30 and 33-37 are allowable, and request that their rejections be withdrawn.

No fee is believed due for this submission. However, should any fees be due for this submission or to avoid abandonment of the application, please charge such fees to Pennie & Edmonds LLP Deposit Account No. 16-1150.

Respectfully submitted,

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 45,479
Max Bachrach (Reg. No.)
PENNIE & EDMONDS LLP
1667 K Street, N.W.
Washington, DC 20006
(202) 496-4400

For: Anthony M. Insogna (Reg. No. 35,203)
PENNIE & EDMONDS LLP
1155 Avenue of the Americas
New York, New York 10036
(212) 790-9090